

**REMARKS**

Please consider the application in view of the following remarks. Applicant thanks the Examiner for indicating that claims 10-13, 16, and 17 are allowable and for carefully considering this application.

**Disposition of Claims**

Claims 10-17 are pending in this application. Claims 10, 14, and 16 are independent. The remaining claims depend, directly or indirectly, from claims 10, 14, and 16.

**Rejections under 35 U.S.C. § 103**

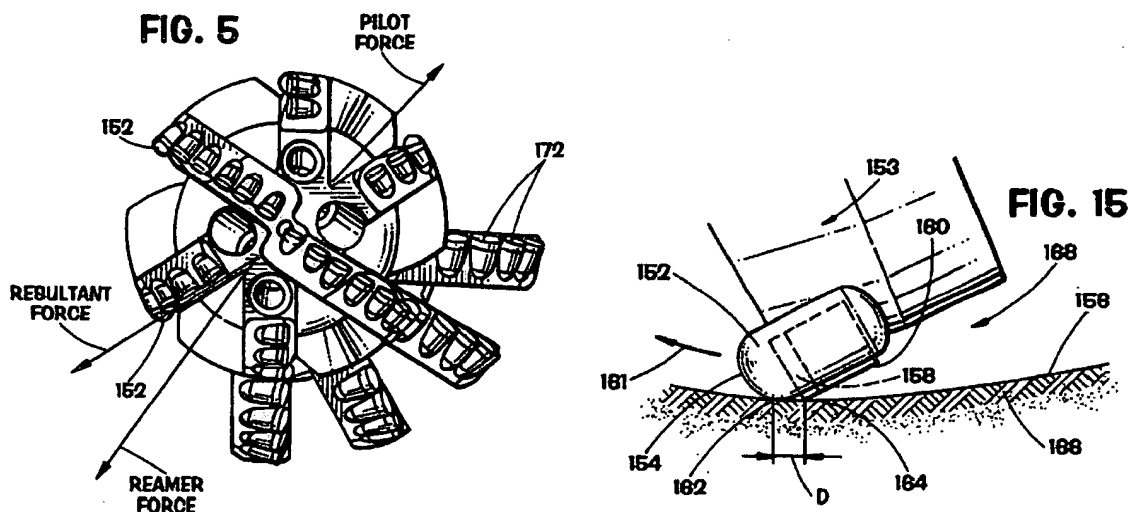
U.S. Patent No. 5,765,653 and U.S. Patent No. 5,678,644

Claims 14 and 15 were rejected under 35 U.S.C. § 103 as being obvious over U.S. Patent No. 5,765,653 ("Doster") in view of U.S. Patent No. 5,678,644 ("Fielder"). This rejection is respectfully traversed.

Claim 14 recites a reaming tool that comprises a body adapted to couple to a drill string at both axial ends and a plurality of reaming blades affixed to the body. Selected ones of the plurality of reaming blades have at least one cutter attached thereto, and at least one of the selected ones of the plurality of reaming blades has at least one insert on a laterally outermost surface. Claim 14 further recites that the plurality of reaming blades comprises at least one radially most extensive reaming blade.

With reference to the embodiment shown by Fielder in Figure 5 (shown below), Fielder discloses a bi-center drill bit that includes a pilot section that imposes a pilot force and a reamer section that imposes a reamer force. On the pilot section of the bi-center drill bit, a

button 152 with a bullet-shaped sliding surface is used to slidingly engage with the borehole wall rather than cut into the borehole wall (col. 6, lines 6-35). Figure 5 only shows the buttons 152 on the pilot section on the pilot blades, not the reaming blades like the inserts recited in claim 14. Further, the button is positioned to be exactly the same diameter as the cutting face of the pilot section, in which the button will protect the cutting elements on the cutting face. With reference to Figure 15 (also shown below), buttons 152 are disposed on the front of the blade, not on the laterally outermost surface of a blade as recited in claim 14. The outermost surface of the blade occurs in the middle of the blade. Doster does not provide that which Fielder lacks, namely having at least one insert on a laterally outermost surface of the reaming blades, with respect to independent claim 14.



In view of the above, Fielder and Doster, whether considered separately or in combination, fail to show or suggest the present invention as recited in claim 14. Thus, claim 14 is patentable over Fielder and Doster. Claim 15, which depends from claim 14, is allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

U.S. Patent No. 6,269,893

Claims 15 was rejected under 35 U.S.C. § 103 as being obvious over U.S. Patent No. 5,765,653. ("Doster") in view of U.S. Patent No. 6,269,893 ("Beaton"). This rejection is respectfully traversed.

Applicant respectfully notes that the present application claims the benefit of U.S. Patent No. 6,386,302 (the "302 Patent"), which was filed on September 9, 1999, assignment recorded at Reel 010237, Frame 0210, assigned to Smith International, Inc. Beaton has a filing date of June 30, 1999. Beaton, because of common inventorship and assignment to the present application, by way of an Assignment recorded at Reel 010088, Frame 0431, assigned also to Smith International, Inc., does not constitute Prior Art under any subsection of 35 U.S.C. § 102. Therefore, the § 103 rejection of claim 15 is untenable and should be withdrawn. Accordingly, withdrawal of this rejection is respectfully requested.

**Conclusion**

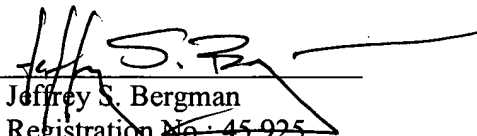
Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 05516/045003).

Application No.: 10/633,796

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Respectfully submitted,

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